

REMARKS

Applicants respectfully requests entry of the amendments and remarks submitted herein. Claims 1-53 have been canceled and new claims 54-136 have been added. Support for new claims 54-136 can be found in the originally filed claims and throughout the specification. Reconsideration of the pending application is respectfully requested.

Objection to the Specification

The Examiner indicated that the specification is objected to because it contains active internet links. Applicants have amended the specification at pages 21 and 23 to remove the hyperlinks. In view of the amendments, Applicants respectfully request that the objection to the specification be withdrawn.

The 35 U.S.C. §112 Rejections

Claim 31 stands rejected under 35 U.S.C. §112, second paragraph, as the Examiner asserted that claim 31 is indefinite for failing to particularly point out and distinctly claim the subject matter that Applicants regard as the invention.

The Examiner indicated that claim 31 is confusing because “said portion” lacks proper antecedent basis. Applicants have canceled claim 31 without prejudice to continued prosecution and submitted new claims 68 and 83 that correspond essentially to canceled claim 31. New claims 68 and 83 do not recite “said portion.” Therefore, Applicants respectfully submit that the rejection of claim 31 under 35 U.S.C. §112, second paragraph, is moot and should not be applied to new claims 68 and 83.

The 35 U.S.C. §102 Rejections

Claims 1-27 stand rejected under 35 U.S.C. §102(a) as being anticipated by Espy et al. (*J. Clin. Micro.*, 2000). Applicants respectfully traverse this rejection.

Applicants have canceled claims 1-53 without prejudice to continued prosecution, and have added new claims 54-136. New claims 54-136 correspond to the originally filed method claims, but additionally recite at least one primer or one probe sequence.

Applicants note that the Espy et al. manuscript was accepted for publication on November 30, 1999 (see the first page of the publication). Applicants submit that the date of acceptance, which predates the date of publication, establishes that the inventors were in possession of the claimed invention prior to the publication date. Applicants respectfully submit that the rejection of claims 1-27 under 35 U.S.C. §102(a) is moot and should not be applied to new claims 54-136.

The 35 U.S.C. §103 Rejections

Claims 1, 5-27, and 30-33 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Greenberg et al. (U.S. Patent No. 5,846,706) in view of Wittwer et al. (U.S. Patent No. 6,140,054). Claims 45-50 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Greenberg et al. (U.S. Patent No. 5,846,706) in view of Livak et al. (1995). Claims 51-53 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Greenberg et al. (U.S. Patent No. 5,846,706) in view of Higuchi et al. (1992). These rejections are respectfully traversed.

Applicants have canceled claims 1-53 without prejudice to continued prosecution, and have added new claims 54-136. New claims 54-136 correspond to the originally filed method claims, but additionally recite at least one primer or one probe sequence. Since original claims 3 and 4 were not rejected as being obvious over the cited art, and since the Examiner indicated that original claims 28 and 29 were allowable if rewritten so as not to depend from a rejected claim, Applicants submit that new claims 54-136 are neither anticipated nor obvious over the cited art. None of the references, alone or in combination, teach or suggest using the particular primer and/or probe sequences recited in new claims 54-136. Therefore, Applicants respectfully submit that the rejections of claims 1, 5-27, and 30-33, 45-50, and 51-53 under 35 U.S.C. §103 are moot and should not be applied to new claims 54-136.

Applicant : Thomas F. Smith et al.  
Serial No. : 10/066,432  
Filed : January 31, 2002  
Page : 26 of 26

Attorney's Docket No.: 07039-246001

CONCLUSION

Enclosed is a \$3,506 check for excess claim fees. Please apply any other charges or credits to Deposit Account 06-1050.

Respectfully submitted,

Date: May 12, 2004

  
M. Angela Parsons, Ph.D.  
Reg. No. 44,282

Fish & Richardson P.C., P.A.  
60 South Sixth Street  
Suite 3300  
Minneapolis, MN 55402  
Telephone: (612) 335-5070  
Facsimile: (612) 288-9696

60198647.doc